

Application No. 09/854,718

RD-28013-2

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant's May 3, 2004 Amendment pointed out that Nielsen does not teach or suggest::

[a] system that comprises "an abrasion testing device, an elongation testing device" or "hydrolytic testing device" or a method of applying 'an abrasion test, an elongation test, solvent exposure test" or "a hydrolytic test" or "applying varying abrasion test results" or a method of "abrasion testing" and "detecting a "varying abrasion test result pattern."

May 3, 2004 Amendment page 10, lines 5 to 9.

The quoted language in this May 3, 2004 Amendment argument are precise claim limitations of independent claims 1, 19 and 46.

The May 3, 2004 Amendment then stated:

If the PTO disagrees, the PTO is respectfully requested to identify the particular language in Nielsen that purports to teach or suggest the limitations of the claims or withdraw the 35 U.S.C. §102(a). *See In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

May 3, 2004 Amendment page 10, lines 5 to 9.

Apparently in response, the Final Rejection states:

Contrary to the applicant's assertion and in order to answer the request by the applicant to point out the language in Nielsen which indicates a solvent exposure test, the examiner draws attention firstly to column 8, lines 26-40 which clearly indicates that the device and methodology taught in Nielsen are directed towards an interrogative procedure to test materials and polymers.

Final Rejection page 2, lines 7 to 11.

Application No. 09/854,718

RD-28013-2

First the Final Rejection mischaracterizes "applicant's assertion." Applicant argues that Nielsen does not teach or suggest the invention *claimed* in the claims not just a system "directed towards an interrogative procedure to test materials and polymers" or to a "solvent exposure test." Claim 1, claims:

Further, Nielsen "column 8, lines 26-40." in its entirety, only states:

This invention provides a method for rapidly characterizing or screening arrays of multiple materials or polymers for physical and chemical properties, wherein samples of the materials or polymers have been created at known locations on a substrate surface. The materials or polymers can be combined with at least one environment-sensitive dye or optical probe, and the optical properties of the dye or optical probe are observed under conditions that allow the parallel or sequential measurement of the absolute or relative properties of the materials or polymers in the array. This invention enables the parallel or rapid sequential screening (i.e., optical measurement of various physical or chemical properties) of at least 5 materials, alternatively, the screening of at least 10 materials, alternatively, the screening of at least 20 materials, alternatively, the screening of at least 50 materials, alternatively the screening of at least 100 materials, ...

This disclosure has nothing to do with the system invention *claimed* in the present application. The claimed system comprises "a testing device (108) selected from the group consisting of an abrasion testing device, an elongation testing device, solvent exposure testing device, exposure to fluid testing device and a hydrolytic testing device to apply a varying test onto a combinatorial array,..." "a combinatorial array (12) having a ... plurality of predefined regions comprising one or more *test result* samples and reference regions *resulting from testing in the testing device*,..." and "a detector (26) operable to measure resultant radiation (22) for each of the plurality of predefined [test result] regions," (limitations of independent claim 1 with emphasis added).

A "device" "directed towards an interrogative procedure to test materials and polymers." is not a teaching or suggestion of the particular structure of the claim 1 (and dependent claims) invention.

This disclosure has nothing to do with the method invention *claimed* in the present application. The claimed method comprises ""applying a *varying test* onto the

Application No. 09/854,718

RD-28013-2

*coated substrate* to form an array of combinatorial *varying test result regions*,..." "exposing the array of *varied test result regions* to incident radiation,..." "collecting resultant *radiation (22) for the varied test regions* of the combinatorial array (12),..." and "determining performance of *varied test result regions* according to respective resultant radiation," (limitations of independent claim 19 with emphasis added).

A "methodology" "directed towards an interrogative procedure to test materials and polymers." is not a teaching or suggestion of the particular steps of the claim 19 (and dependent claims) invention.

The Final Rejection continues:

Secondly, by looking to Example 4 at column 12 of Nielsen, it is clear that the solvent exposure device and method of the applicants invention is [sic, are] taught. As pointed out in the previous Office action, solvent is added in varying quantity [sic, quantities] to an array of polymers to create a variety of samples.

Final Rejection page 2, lines 12 to 15.

Again, the PTO mischaracterizes the claimed invention. Claim 1 claims a "solvent exposure *testing* device," (emphasis added) not a "solvent exposure device." While a device that adds solvent may be a solvent adding device or a synthesis device it is not a "solvent exposure testing device," absent some disclosure supporting a test. No claim 1 "solvent exposure testing device" is taught or suggested in the Nielsen Example.

Similarly with respect to claim 19, a disclosure of adding a "solvent" "in varying quantities to an array of polymers to create a variety of [product] samples" has nothing to do with the particular iterative steps of the claim 19 (and dependent claims) invention. Creating an array of varying dissolved products is not the same as a step of "applying a varying test onto the coated substrate to form an array of combinatorial varying test result regions " as claimed in claim 19 and dependent claims.

The Final Rejection continues:

Lines 19-21 of column 13 teach the varying of testing conditions and the observation of the effect of polymer plasticization by the added solvents,

Application No. 09/854,718

RD-28013-2

the solvent is exposed to the polymers in varying degrees, the temperature varied across the array, the results of the exposure of the solvent on the polymers observed

This is a mischaracterization of the Nielsen disclosure. T Nielsen reference, column 13, lines 17 to 22 states:

To each solution is also added an appropriate amount of dye 1, and films of each sample are cast on glass substrate as in example 3. The glass transition temperature of each film is measured optically as in example 3, heating from -40.degree. C. to 130.degree. C. over 40 minutes, showing the effects of polymer plasticization by the added solvents.

But that is the end of the Nielsen Example 4 process and system disclosure. Assuming the solvent is added to the polymer by a device (and this is not disclosed), Example 4 has no teaching or suggestion of "a detector (26) operable to measure resultant radiation (22) for each of the plurality of predefined [test result] regions," (claim 1) or "applying a *varying test* onto the *coated substrate* to form an array of combinatorial *varying test result regions*,..." "exposing the array of *varied test result regions* to incident radiation,..." "collecting resultant *radiation (22) for the varied test regions* of the combinatorial array (12),..." and "*determining performance of varied test result regions* according to respective resultant radiation," (claim 19).

This argument was made in Applicant's previous Amendment. The PTO has not responded.

The Final Rejection states:

Nielsen teaches a device and method for optical analysis of a combinatorial array comprising the following in regards to claims 1-4, 7-9, 11-12, 15-20, 22-25, 28, 31-32, 46-48, 51-53, 55, and 56:

1) A combinatorial array having a surface with a plurality of predefined regions (Col. 6 Line 44-Col. 7 Line 14) comprising a plurality of spatially divided sample or reference regions measured simultaneously (Col. 10 Lines 64-68), where the regions may be concave or convex (dimpled or beaded), the array may comprise a substrate with a deposited coating (Col. 7 Lines 33-43) where the substrate may be comprised of glass, silicon, metals, ceramics (Col. 7 Line 64) and the coating may be transparent, opaque, organic, or inorganic (Col. 7 Lines 45-50. Nielsen

Application No. 09/854,718

RD-28013-2

further teaches the varying of test conditions across a sample array to test a variety of physical conditions including temperature exposure testing (Col. 12 Example 3), since a physical test is being performed on the array of samples, Nielsen includes testing means such as an optical system (Col. 10) for measuring various physical properties of the array elements.

But Applicant claims a "combinatorial array (12) having... reference regions *resulting from testing in [a] testing device*" (claim 1, emphasis added). The Final Rejection does not address this claim limitation and Nielsen does not teach or suggest this claim recitation.

The Final Rejection states that Nielsen discloses:

2) A radiation source for exposing the array to incident radiation of between  $10^{-14}$  meters and  $10^4$  meters. (Col. 7 Lines 15-20),

But Applicant claims "a radiation source (16) operable, to expose each of the plurality of predefined regions [*"resulting from testing in [a] testing device"*] to incident radiation..."

The Final Rejection states that Nielsen discloses:

3) A detector in the form of a CCD for collecting the radiation reflected from the array (Col. 11 Lines 30-40) where spatial filters compensate for the curvature or structures affecting the focus of the excitation radiation and an optical train filters selected incident radiation (Col. Line 8-15).

But Applicant claims "a detector (26) operable to measure resultant radiation (22) for each of the plurality of predefined [*resulting from testing in [a] testing device*"] regions of the combinatorial array (12)"

The Final Rejection states that Nielsen discloses:

4) A means for applying a test to each region of the array, in the instant case, Nielsen teaches a means for controlling the temperature of the environment (See Example 1 on Col.1) and further teaches a solvent exposure testing device which varies the exposure of a solvent in a plurality of predefined regions (Col. 13 Lines -20).

But Applicant claims "a testing device (108)... to apply a varying test onto a combinatorial array (12) *to produce a combinatorial array of varying test results*" (claim

Application No. 09/854,718

RD-28013-2

1, emphasis added) that is combined with a subsequent "radiation source (16) operable, to expose each of the plurality of predefined regions of the combinatorial array (12)," with a subsequent "detector (26) operable to measure resultant radiation (22) for each of the plurality of predefined regions of the combinatorial array (12)" and with a subsequent "computer to functionally control the operation of the system and determine the relative performance of each of the plurality of predefined regions of the combinatorial array (12)."

The Final Rejection states that Nielsen discloses:

5) A computer to control the system and determine the performance of each test region (Col. 5 Lines 22-45).

But Applicant claims a "computer to functionally control the operation of the system p including the testing device, combinatorial array (12 and radiation source particularly claimed in claim 1] and determine the relative performance of each of the plurality of predefined regions [*resulting from testing in [a] testing device*"] of the combinatorial array (12)."

The 35 U.S.C. 102(a) Final Rejection does not address the claimed features of Applicant's system invention. Further, while the Final Rejection rejects Applicant's method claims 19 and 46 and dependent method claims under 35 U.S.C. 102(a), 35 U.S.C. 102(a), discussion of the Final Rejection does not address these claims. This is improper examination.

The Final Rejection states:

Regarding claims 10 and 54, Nielsen teaches that the substrate may be a flat polymer thin film and defines a substrate any [sic, as] material having a rigid or semi-rigid surface (Col. 8 Line 61-Col. 9 Line 10).

But in claim 54, Applicant claims a method comprising applying varying testing conditions across a substrate comprising ""a deposited coating that comprises a film."

The 35 U.S.C. 102(a) Final Rejection does not address the claimed features of Applicant's method comprising applying varying testing conditions across a substrate

Application No. 09/854,718

RD-28013-2

comprising "a deposited coating that comprises a film." This is improper examination.

The Final Rejection states:

Regarding claims, 5-6, 26-27, 49-50, Nielsen teaches that the substrate having a thin film deposited thereon which contains a luminescent dye. The addition of the dye to the coating material makes the thin film layer inherently luminescent (Col. 8 Line 61 Col. 9 Line 10).

However, an added dye is not a teaching or suggestion of "inherent." the term "inherent" means "involved in the constitution or essential character of something." McGraw-Hill Dictionary of Scientific and Technical Terms, 5<sup>th</sup> Ed., p 601 (1994), "Added dye" is the opposite of "inherent."

## II. CONCLUSION

Proper examination requires examination of the *claimed* invention. With a 35 U.S.C. §102(b) rejection, the PTO must show "[t]he identical invention... shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). A proper 102(b) rejection must be supported by a teaching of "elements" "arranged as required by the claim(s)." *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Final Rejection selects bits and pieces of the Nielsen reference to support the 35 U.S.C. §102(b) rejection without regard to the elements or steps of the invention as recited in the claims. The Final Rejection has identified a "gist" as the invention, and has examined the "gist" – not the claimed invention. The Final Rejection fails to address all the arguments raised in Applicant's previous Amendment.

The present office action is improper and the finality of the action is premature as set out above. In this respect, Applicants include with this Request for Reconsideration, an MPEP 706.07(c) AND MPEP 706.07(d) REQUEST TO WITHDRAW FINAL REJECTION addressed to the Supervisory Primary Examiner. This REQUEST is filed pursuant to MPEP 706.07(c) and MPEP 706.07(d) as prerequisite to a Petition to the Commissioner of Patents.

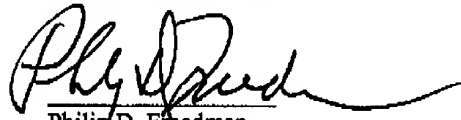
Application No. 09/854,718

RD-28013-2

In view of the foregoing remarks, it is respectfully submitted that claims 1 to 11, 13 to 20, 22 to 32 and 46 to 59 are allowable. Reconsideration and allowance or withdraw of the Final Rejection are requested.

Should the Examiner believe that any further action is necessary in order to place this application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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